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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,971	05/08/2001	Linda Ann Roberts	BS00-338	1307

28970   7590   12/05/2003

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ART UNIT	PAPER NUMBER
2645	6

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/849,971	ROBERTS ET AL.
	Examiner	**Art Unit**	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04 September 2003_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1.   Claims 1-8, 11, 15, 20 and 21 are rejected under 35 U.S.C. 102(b) as being

anticipated by Epler et al. US Patent No. 5,825,867.

1.1   Regarding claim 1, Epler discloses a method of enhanced call waiting. Epler

teaches:

associating a plurality of VIP (priority) codes with a called telephone number

(column 11, lines 55-57; column 14, lines 16-30), wherein each code is mapped with a

party line telephone number (priority level of a plurality priority levels) associated with

the called telephone number (column 5, lines 42-54), each party line telephone number

generates a different distinctive call waiting tone at a called party's telephone to indicate

the level of urgency or importance (the plurality priority level is associated with a priority

alert signal) (column 6, lines 5-18, 24-28).

receiving a telephone call from caller 12 while called party 10 is engaged in

another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36;

column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a

database, and alerting the called party with a distinctive call waiting tone, indication the

urgency or importance of the telephone call, if the VIP code entered is valid (column 5,

lines 33-60; column 6, lines 5-18, 24-28; column 14, lines 16-30);

connecting caller 12 to a voice messaging system if the VIP code does not match

(column 14, lines 23-29); and

establishing communication between caller 12 and called party 10 if called party

10 so desires (column 1, lines 26-38).

1.2   Regarding claim 2, Epler teaches that the VIP code is unique to a caller (column

11, lines 55-57; column 6, lines 13-18).

1.3   Regarding claim 3, Epler teaches that the VIP code is provided by called party 10

to caller 12 (column 11, lines 52-57).

1.4   Regarding claim 4, Epler teaches that a priority alert signal is a regular call

waiting tone (column 5, lines 56-60).

1.5   Regarding claims 5 and 6, Epler teaches prompting caller 12 to leave a message

if no VIP code is entered, or the VIP code entered does not match (column 5, lines 39-

42; column 14, lines 23-27).

1.6   Regarding claim 7, Epler discloses a method of enhanced call waiting. Epler

teaches:

associating a plurality of VIP (priority) codes with a called telephone number

(column 11, lines 55-57; column 14, lines 16-30), wherein each code is mapped with a

party line telephone number (priority level of a plurality priority levels) associated with

the called telephone number (column 5, lines 42-54);

generating a different distinctive call waiting tone, associated with a party line

telephone number, at a called party's telephone to indicate the level of urgency or

importance (column 6, lines 5-18, 24-28).

receiving a telephone call from caller 12 while called party 10 is engaged in

another call with another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36;

column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a

database, and alerting the called party with a distinctive call waiting tone, indication the

urgency or importance of the telephone call, if the VIP code entered is valid (column 5,

lines 33-60; column 6, lines 5-18, 24-28; column 14, lines 16-30); and

establishing communication between caller 12 and called party 10 if called party

10 so desires (column 1, lines 26-38).

1.7   Regarding claim 8, as discussed in claim 7, each VIP code represent a different

caller (column 11, lines 55-57).

1.8   Regarding claim 11, Epler discloses a system of enhanced call waiting in figure

1, comprising:

a switch 20 in communication with a telephone line (column 3, lines 17-23),

wherein the switch is configured to detect incoming calls intended for user 10 who is

already engaged in a first communication with another caller 12 (column 4, lines 43-

45);

a processor (computer 56) in communication with the switch, wherein the

processor is configured to review information associated with user 10 (column 3, lines

33-36; column 4, lines 37-55) to determine whether user 10 is a subscriber of the

enhanced call waiting subscriber (column 5, lines 32-35);

wherein the processor receives a query from the switch and identifies that user

10 is a subscriber of the system, then instruct the switch to solicit a VIP code from caller

12 (column 5, lines 35-39; column 14, lines 16-30);

wherein the processor instructs the switch to interrupt the first communication

with a priority alert signal if the VIP code provided by caller 12 matches one of a plurality

of VIP codes stored in database 55, wherein each of the plurality VIP code is further

mapped with a party line telephone number (priority level) and each party line telephone

number is associated with a priority alert signal (column 5, lines 42-54; column 6, lines

5-18, 24-28; column 14, lines 16-30); and

establishing communication between caller 12 and user 10 if user 10 so desires

(column 1, lines 26-38).

1.9   Regarding claim 15, Epler discloses a method of enhanced call waiting. Epler

teaches:

associating two or more VIP (priority) codes with a called telephone number

(column 11, lines 55-57; column 14, lines 16-30), wherein each of the two or more

codes is mapped with a party line telephone number (priority level of a plurality priority

levels) associated with the called telephone number (column 5, lines 42-54);

producing a different distinctive call waiting tone, associated with a party line

telephone number, at a called party's telephone to indicate the level of urgency or

importance (column 6, lines 5-18, 24-28).

receiving a telephone call from caller 12 while called party 10 is engaged in

another call with another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36;

column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a

database, and alerting the called party with a distinctive call waiting tone, indication the

urgency or importance of the telephone call, if the VIP code entered is valid (column 5,
lines 33-60; column 6, lines 5-18, 24-28; column 14, lines 16-30); and

establishing communication between caller 12 and called party 10 if called party
10 so desires (column 1, lines 26-38).

1.10   Regarding claim 20, Epler discloses a method of enhanced call waiting. Epler
teaches:

associating a plurality of VIP (priority) codes with a called telephone number
(column 11, lines 55-57; column 14, lines 16-30), wherein each code is mapped with a
party line telephone number (priority level of a plurality priority levels) associated with
the called telephone number (column 5, lines 42-54);

assigning a different distinctive call waiting tone, associated with the party line
telephone number, at a called party's telephone to indicate the level of urgency or
importance (column 6, lines 5-18, 24-28).

receiving a telephone call from caller 12 while called party 10 is engaged in
another call with another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36;
column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a
database, and alerting the called party with a distinctive call waiting tone, indication the
urgency or importance of the telephone call, if the VIP code entered is valid (column 5,
lines 33-60; column 6, lines 5-18, 24-28; column 14, lines 16-30); and

establishing communication between caller 12 and called party 10 if called party

10 so desires (column 1, lines 26-38).

1.11   Regarding claim 21, Epler teaches that the VIP code is unique to each caller

(column 11, lines 55-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 7 and 11-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Eisdorfer, US 5,636,269 in view of Bushnell US 6,519,335.

2.1   Regarding claim 1, Eisdorfer discloses a method of intelligent call waiting.

Eisdorfer teaches:

associating a plurality of PINs (priority codes) with a called telephone number

(column 2, lines 15-24, 38-46), wherein each PIN is associated a particular person or

group (column 3, lines 2-7), each particular person or group is associated with a

different distinctive call waiting tone at a called party's telephone (column 3, lines 2-7,

15-21);

receiving a telephone call from a calling party while the called party is engaged in

another call with a third party (column 2, lines 9-10; column 4, lines 53-57);

receiving a PIN from the caller (column 2, lines 38-45; column 5, lines 9-17);

determining whether the PIN received matches one stored in a database, and

alerting the called party with a distinctive call waiting tone if the PIN entered is valid

(column 3, lines 2-7, 15-21);

connecting the caller to a voice messaging system if the PIN does not match

(column 3 lines 10-12); and

establishing communication between the caller and the called party if the called

party desires so (column 1, lines 16-20; column 2, lines 15-24).

Eisdorfer teaches that each PIN is associated with a particular person, and

distinctive call waiting tone (column 3, lines 2-9, 15-21). Eisdorfer also teaches that the

call may indicate the importance of the call, such as very important or less importance,

but fails to teach each PIN represents a priority level.

However, Bushnell discloses a method and system for call waiting applications.

Bushnell teaches that different individuals may be assigned with different priority levels

associated with different distinctive alerting tones indicating different priority levels

(column 7, lines 66-67; column 8, lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the Eisdorfer's reference with the teaching of

Bushnell, so that each PIN (and its associated particular individual and alerting tone)

would have been assigned a priority level, because such a modification would have

enabled a called party to determine the importance of an incoming call in call waiting, and would have helped the called party to decide whether to answering the incoming call or not.

2.2   Regarding claim 7, Eisdorfer discloses a method of intelligent call waiting. Eisdorfer teaches:

associating a plurality of PINs (priority codes) with a called telephone number (column 2, lines 15-24, 38-46), wherein each PIN is associated a particular person or group (column 3, lines 2-7), each particular person or group is associated with a different distinctive call waiting tone at a called party's telephone (column 3, lines 2-7, 15-21);

receiving a telephone call from a calling party while the called party is engaged in another call with a third party (column 2, lines 9-10; column 4, lines 53-57);

receiving a PIN from the caller (column 2, lines 38-45; column 5, lines 9-17);

determining whether the PIN received matches one stored in a database, and alerting the called party with a distinctive call waiting tone if the PIN entered is valid (column 3, lines 2-7, 15-21); and

establishing communication between the caller and the called party if the called party desires so (column 1, lines 16-20; column 2, lines 15-24).

Eisdorfer teaches that each PIN is associated with a particular person, and distinctive call waiting tone (column 3, lines 2-9, 15-21). Eisdorfer also teaches that the

call may indicate the importance of the call, such as very important or less importance, but fails to teach each PIN represents a priority level.

However, Bushnell discloses a method and system for call waiting applications. Bushnell teaches that different individuals may be assigned with different priority levels associated with different distinctive alerting tones indicating different priority levels (column 7, lines 66-67; column 8, lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Eisdorfer's reference with the teaching of Bushnell, so that each PIN (and its associated particular individual and alerting tone) would have been assigned a priority level, because such a modification would have enabled a called party to determine the importance of an incoming call in call waiting, and would have helped the called party to decide whether to answering the incoming call or not.

2.3   Regarding claim 11, Eisdorfer discloses a system for call waiting in figure 1, comprising:

a switch (SSP 18) in communication with telephone 10, wherein the switch is configured to detect an incoming call to telephone 10 from a caller at telephone 14, while telephone 10 is in communication with telephone 12 (column 4, lines 53-57);

a processor (SCP 24) in communication with the switch, wherein the processor is configured to review information associated with telephone 10 (column 5, lines 1-8),

wherein when the switch detects an incoming call intended for telephone 10, the

switch launches a query comprising the telephone number of telephone 10 (column 5,

lines 1-8);

wherein the processor instructs the switch to prompt the caller for a PIN (column

5, lines 9-17);

wherein the processor instructs the switch to interrupt the first communication

with an alert signal if the PIN provided by the caller at telephone 14 matches one of a

plurality of PINs stored in a database, and each PIN is associated with an different alert

signal (column 5, lines 17-20); and

connecting telephone 14 to telephone 10 if the user of telephone 10 so desires

(column 1, lines 16-20; column 2, lines 15-24).

Eisdorfer teaches that each PIN is associated with a particular person, and

distinctive call waiting tone (column 3, lines 2-9, 15-21). Eisdorfer also teaches that the

call may indicate the importance of the call, such as very important or less importance,

but fails to teach each PIN represents a priority level.

However, Bushnell discloses a method and system for call waiting applications.

Bushnell teaches that different individuals may be assigned with different priority levels

associated with different distinctive alerting tones indicating different priority levels

(column 7, lines 66-67; column 8, lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the Eisdorfer's reference with the teaching of

Bushnell, so that each PIN (and its associated particular individual and alerting tone)

would have been assigned a priority level, because such a modification would have

enabled a called party to determine the importance of an incoming call in call waiting,

and would have helped the called party to decide whether to answering the incoming

call or not.

2.4   Regarding claim 12, the Eisdorfer's reference, modified by Bushnell, Eisdorfer

teaches that the switch (SSP 18) is provisioned with a trigger (column 4, lines 63 to

column 5, line 3).

2.5   Regarding claim 13, as discussed in claim 11, the switch is a service switching

point (SSP) and the processor is a service control point (SCP).

2.6   Regarding claim 14, the Eisdorfer's reference, modified by Bushnell, Eisdorfer

further teaches that a priority alert signal may be a regular call waiting tone (column 3,

lines 15-21).

2.7   Regarding claim 15, Eisdorfer discloses a method of intelligent call waiting.

Eisdorfer teaches:

          associating a at least two PINs (priority codes) with a called telephone number

(column 2, lines 15-24, 38-46), wherein each PIN is associated a particular person or

group (column 3, lines 2-7), each particular person or group is associated with a

different distinctive call waiting tone at a called party's telephone (column 3, lines 2-7,

15-21);

receiving a telephone call from a calling party while the called party is engaged in

another call with a third party (column 2, lines 9-10; column 4, lines 53-57);

receiving a PIN from the caller (column 2, lines 38-45; column 5, lines 9-17);

determining whether the PIN received matches one stored in a database, and

alerting the called party with a distinctive call waiting tone if the PIN entered is valid

(column 3, lines 2-7, 15-21); and

establishing communication between the caller and the called party if the called

party desires so (column 1, lines 16-20; column 2, lines 15-24).

Eisdorfer teaches that each PIN is associated with a particular person, and

distinctive call waiting tone (column 3, lines 2-9, 15-21). Eisdorfer also teaches that the

call may indicate the importance of the call, such as very important or less importance,

but fails to teach each PIN represents a priority level.

However, Bushnell discloses a method and system for call waiting applications.

Bushnell teaches that different individuals may be assigned with different priority levels

associated with different distinctive alerting tones indicating different priority levels

(column 7, lines 66-67; column 8, lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the Eisdorfer's reference with the teaching of

Bushnell, so that each PIN (and its associated particular individual and alerting tone)

would have been assigned a priority level, because such a modification would have

enabled a called party to determine the importance of an incoming call in call waiting, and would have helped the called party to decide whether to answering the incoming call or not.

2.8   Regarding claim 16, the as discussed in claim 15, plurality of priority levels are associated with a plurality of priority alerting signals, wherein each of the plurality alerting signals represents a different caller.

2.9   Regarding claim 17, the as discussed in claim 15, plurality of priority levels are associated with a plurality of priority alerting signals, wherein each of the plurality alerting signals represents a priority level.

2.10   Regarding claim 18, the Eisdorfer's reference, modified by Bushnell, Eisdorfer teaches that a PIN is unique to a particular caller (column 3, lines 2-5).

3.   Claims 9, 10, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. US 5,825,867 in view of Groen et al. US 6,650,746.

Epler teaches prompting a caller to enter a code in call waiting, and generating a distinctive alert signal in accordance with the code. Epler fails to teach providing the caller with two or more codes, each code associated with a priority level.

However, Groen discloses an urgency call indication to called party through distinctive notification in figure 1. Groen teaches prompting a caller to enter an urgency

level indicator (priority code) and generating a distinctive ring pattern in accordance with

the indicator (Abstract, column 3, 28-32, 46-54; column 4, lines 8-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the Epler's reference with the teaching of Groen,

so that a caller would have been given two or more priority code, each associated with a

distinctive alerting tone for indicting the level of priority, because such a modification

would have given a called party more informed information, helping the called party to

decide whether to answering the incoming call or not.

4.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Eisdorfer, US 6,519,3355,636,269 in view of Bushnell US 6,519,335 and further in view

of Groen et al. US 6,650,746.

The Eisdorfer's reference, modified by Bushnell, teaches prompting a caller to

enter a PIN in call waiting, and generating a distinctive alert signal in accordance with

the code, but fails to teach providing the caller with two or more codes, each code

associated with a priority level.

However, Groen discloses an urgency call indication to called party through

distinctive notification in figure 1. Groen teaches prompting a caller to enter an urgency

level indicator (priority code) and generating a distinctive ring pattern in accordance with

the indicator (Abstract, column 3, 28-32, 46-54; column 4, lines 8-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to further modify the Eisorfer's reference, which was

modified by Bushnell, with the teaching of Groen, so that a caller would have been given two or more priority code, each associated with a distinctive alerting tone for indicting the level of priority, because such a modification would have given a called party more informed information, helping the called party to decide whether to answering the incoming call or not.

Response to Arguments

5.   Applicant's arguments filed 09/04/2003 have been fully considered but they are not persuasive.
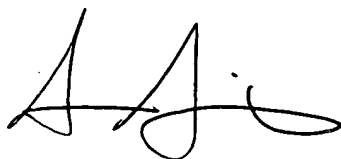
The applicant misinterpreted the Epler reference and argued that in Epler, a caller entered a telephone number, not a priority code. See pages 13 and 14 of the Remark. In fact, Epler teaches that when a caller calls a called party while the called party is engaged in a communication with a third party, the caller is prompted to enter a code. When a valid code is received, a switch in the Epler's system, dials a party line number, in accordance with the code, of the called party's telephone line to generate a distinctive call waiting tone (column 5, lines 32-60; column 6, lines 5-18, 24-28). In other words, Epler teaches mapping different codes entered by callers to different party line numbers for generating different call waiting tones on the called party's telephone to indicate the urgency or importance (priority levels) of incoming calls. A caller is prompted to enter a code, NOT a telephone number.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communication from the

examiner should be directed to Simon Sing whose telephone number is (703) 305-3221.

The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-4750.

S.S.

11/24/2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600